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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Jordi Alborno

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CANTOR COLBURN LLP-IBM POUGHKEEPSIE

20 Church Street

22nd Floor

Hartford, CT 06103

EXAMINER

WALSH, JOHN B

ART UNIT

PAPER NUMBER

2451

NOTIFICATION DATE

DELIVERY MODE

12/22/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

usptopatentmail@cantorcolburn.com

Office Action Summary	Application No. 10/724,969	Applicant(s) ALBORNOZ ET AL.	
	Examiner John B. Walsh	Art Unit 2451	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on RCE of 9/29/08.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13, 14 and 16-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13, 14 and 16-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 13, 14, 16-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claims are drawn to a method. For purposes of 101, a “process” has been given a specialized, limited meaning by the courts. A 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. Neither of these requirements are met by the claims and thus the method is not a patent eligible process under 101.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 13, 14, 16 - 24 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Application Publication 2001/0037453 to Mitty et al.

As concerns claim 13, a method for instant messaging in a network communication system comprising: formulating a combined message to a recipient (0011), said combined message including a predictive code (0012) and a communications message (0012); a state

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variable associated with said recipient (0032;0086), said state variable includes a function (0033;0086); and transmitting said code and said communications message to a recipient (0012); executing the predictive code at the recipient (0034;0056); and delivering the communications message to the recipient if the predictive code returns a first value (0034-validated) and discarding the communications message if the predictive code returns a second value (0081-if not validated must be retransmitted thus initial message is discarded).

As concerns claim 14, transmitting a modifying code to the recipient that causes the persistent state associated with the recipient to be modified (0086;0094).

As concerns claim 16, wherein said state variable corresponds to one or more aspects of a state of said recipient (0086).

As concerns claim 17, wherein said state variable is name spaced based on a selected sender of a message (0086).

As concerns claim 18, wherein said state variable includes one or more parameters (0086;0059).

As concerns claim 19, wherein said parameters include at least one of a state variable name, a sender, and a recipient (0032, 0086).

As concerns claim 20, wherein said state variable is at least one of modified by a sender, determined by selected code operating at said recipient, and updated by selected code operating at said recipient (0086; 0094;0120).

As concerns claim 21, further including storing a state variable on a server separate from a recipient (0048- intermediary 115;0053).

As concerns claim 22, wherein said code evaluates a state of said recipient (0086).

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As concerns claim 23, wherein said a state of said recipient includes whether a messages has been previously received (0086; 0049).

As concerns claim 24, further including establishing a security mechanism at a recipient to ensure that code transmitted to, and executed at, a recipient is noninvasive (0022;0050;0056).

5. Claims 13, 14, 16-23 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,282,709 to Reha et al.

As concerns claim 13, a method for instant messaging in a network communication system comprising: formulating a combined message to a recipient (system 100), said combined message including a predictive code (col. 9, lines 35-40; col. 5, lines 1-12) and a communications message (col. 9, lines 56-60; note applicant indicates at 0005-0006 code and message can be sent separately); a state variable associated with said recipient (col. 2, lines 13-17; software versions), said state variable includes a function (col. 4, lines 1-7; 55-62); and transmitting said code and said communications message to a recipient (col. 9, lines 53-60; col. 7, lines 20-25); executing the predictive code at the recipient (col. 9, lines 53-60; col. 7, lines 20-25); and delivering the communications message to the recipient if the predictive code returns a first value and discarding the communications message if the predictive code returns a second value (col. 9, lines 35-60).

As concerns claim 14, transmitting a modifying code to the recipient that causes the persistant state associated with the recipient to be modified (col. 5, lines 60- col. 6, line 6;version).

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As concerns claim 16, wherein said state variable corresponds to one or more aspects of a state of said recipient (col. 5, lines 60- col. 6, line 6;version).

As concerns claim 17, wherein said state variable is name spaced based on a selected sender of a message (col. 5, lines 17-20; name of file determined by sender).

As concerns claim 18, wherein said state variable includes one or more parameters (software version number is a parameter).

As concerns claim 19, wherein said parameters include at least one of a state variable name, a sender, and a recipient (software version has a name).

As concerns claim 20, wherein said state variable is at least one of modified by a sender, determined by selected code operating at said recipient, and updated by selected code operating at said recipient (col. 9, lines 53-60; col. 7, lines 20-25).

As concerns claim 21, further including storing a state variable on a server separate from a recipient (col. 5, lines 8-10; server version compared to local system).

As concerns claim 22, wherein said code evaluates a state of said recipient (col. 9, lines 35-60).

As concerns claim 23, wherein said a state of said recipient includes whether a messages has been previously received (col. 9, lines 35-60; current or non-existent checked).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,282,709 to Reha et al. in view of U.S. Patent Application Publication 2001/0037453 to Mitty et al.

Reha et al. '709 do not explicitly disclose a security mechanism.

Mitty et al. '453 teach a security mechanism (0022;0050;0056).

It would have been obvious to one having ordinary skill in the art at the time of the invention to provide the system of Reha et al. '709, with a security mechanism, as taught by Mitty et al. '453, in order to provide a means of protecting the integrity of the data on the computer system.

Response to Arguments

8. Applicant's arguments filed September 29, 2008 have been fully considered but they are not persuasive.

The applicant argues Mitty does not teach or suggest "establishing a state variable associated with a recipient, wherein the state variable includes a function" as now presented in claim 13. The claims have been given the broadest reasonable interpretation and Mitty anticipates the claimed invention. Claim 13 is broad in the recital of a "function", and does not recite what the particular "function" is. The recital of establishing a function for the recipient is not linked to any other limitations in claim 13, and thus renders the scope for this limitation to be broader in scope and lends multiple aspects of Mitty's disclosure to anticipate such a limitation. The applicant appears to be inferring some limited meaning to the term "function" within the

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claim without reciting any of those specific limitations. Furthermore limitations from the specification are not read into the claim. Mitty discloses a state variable and it would be inherent for this state to have a "function", such as its role, which can comprise monitoring status of transactions or transforming messages.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John B. Walsh whose telephone number is 571-272-7063. The examiner can normally be reached on Monday-Thursday from 8:00-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 571-272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John B. Walsh/
Primary Examiner, Art Unit 2451

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